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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,902	12/16/1999	WILLIAM C. OLSON	57906-AJPW/S	8227

7590 10/21/2003

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EXAMINER	
LE, EMILY M	

ART UNIT	PAPER NUMBER
1648	17

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/464,902	Applicant(s) OLSON ET AL.	
	Examin r Emily Le	Art Unit 1648	

-- Th MAILING DATE of this communication appears on th cover sheet with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *March 29, 2002* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *78-101* is/are pending in the application.

4a) Of the above claim(s) *78-86, 89-90, and 96-97* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) *87-88, 91-95, and 98-101* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Status of Claims

Claims 1-77 are cancelled. Claims 78-101 are pending. Claims 87-88, 91-95, and 98-101 are under examination. Claims 78-86, 89-90, and 96-97 are withdrawn from examination in view of Applicant's election of Group VI.

Supplemental Election/Restrictions

1. This supplemental restriction is in response to Applicant's amendment, filed July 14, 2003, Paper No. 12. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 87-88, 91-95, and 98-101, drawn to nucleic acid molecule that encodes one or more CDR regions of anti-CCR5 monoclonal antibody designated as PA 14, PA 8, PA 9, PA 10, PA 11, AND PA 12 classified in class 536, subclass 23.53.

II. Claims 87-88, 91-95, and 98-101, drawn to nucleic acid molecule that encodes one or more CDR regions of anti-CCR5 monoclonal antibody designated as PA 14, classified in class 536, subclass 23.53.

III. Claims 87-88, 91-95, and 98-101, drawn to nucleic acid molecule that encodes one or more CDR regions of anti-CCR5 monoclonal antibody designated as PA 8, classified in class 536, subclass 23.53.

IV. Claims 87-88, 91-95, and 98-101, drawn to nucleic acid molecule that encodes one or more CDR regions of anti-CCR5 monoclonal antibody designated as PA 9, classified in class 536, subclass 23.53.

V. Claims 87-88, 91-95, and 98-101, drawn to nucleic acid molecule that encodes one or more CDR regions of anti-CCR5 monoclonal antibody designated as PA 10, classified in class 536, subclass 23.53.

VI. Claims 87-88, 91-95, and 98-101, drawn to nucleic acid molecule that encodes one or more CDR regions of anti-CCR5 monoclonal antibody designated as PA 11, classified in class 536, subclass 23.53.

VII. Claims 87-88, 91-95, and 98-101, drawn to nucleic acid molecule that encodes one or more CDR regions of anti-CCR5 monoclonal antibody designated as PA 12, classified in class 536, subclass 23.53.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II-VII are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because not all subcombination, nucleic acid molecules that are drawn to different antibodies are necessary to produce the combination, a nucleic acid molecule that encodes the CDR

region of an anti-CCR5 monoclonal antibody PA 14, PA 8, PA 9, PA 10, PA 11, AND PA 12. The subcombination has separate utility such as to detect the antibodies.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for each listed Groups will not overlap, restriction for examination purposes as indicated is proper.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Further, Applicant's election with traverse of Group VI in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the restriction is improper because Groups V-VII are not independent from one another and that a restriction can only proper if the separated inventions are independent AND distinct from one another while quoting from MPEP § 802 and 35 U.S.C § 121. This is not found persuasive.

Applicant is taking the teachings of the MPEP out of context. MPEP § 806, states that a restriction is proper if the inventions are able to support separate patents and they are either independent (MPEP § 806.04 - § 806.04(i)) **or** distinct (MPEP § 806.05 - §806.05(i)). In the instant case, each Groups can support a separate patent and that are distinct from one another for each groups are directed Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

The requirement is still deemed proper and is therefore made FINAL unless Applicant admits that the Groups are obvious variants of each other.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Le whose telephone number is (703) 305-4452. The examiner can normally be reached on Monday - Friday, 8 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (703) 308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0169.

E.Le

JAMES HOUSEL 10/20/03
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600